

Application No. 10/024,266
Reply to Office Action of June 23, 2005

Patent
Attorney Docket No. 86052-6

II. REMARKS / ARGUMENTS

A) SUMMARY OF THE AMENDMENTS

Independent Claims 1, 16 and 33 have been amended to clarify the terminology used to refer to the different types of information entered by a user. Support for the claim amendments can be found, *inter alia*, in paragraphs [0037] and [0040] of the application, as published.

Dependent claims 2, 4, 5, 9-13, 17, 20, 21, 25-27, 32-34, 38-41, and 46 have been amended for consistency with the language of amended claims 1, 16 and 33.

Claims 3, 6-8, 14-15, 18, 19, 22, 23, 24, 28-31, 35-37 and 42-45 remain the same.

It is respectfully submitted that no new matter has been added under the present amendment.

B) RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. 102

On page 2 of the Office Action, the Examiner has rejected claims 1, 16 and 33 under 35 U.S.C. 102(b) as being anticipated by Tran '742. The Examiner contends that Tran discloses or inherently teaches all of the limitations of the claims including "delivering information to a user from a computer prompting the user to enter information identifying a project, perform an action specifying a billing-related information, provide information not related to billing-related information (See, for example Figs. 11 and 12)"

Application No. 10:024,266
Reply to Office Action of June 23, 2005

Patent
Attorney Docket No. 86052-6

In light of the amendments made herein, the applicant respectfully traverses the Examiner's rejection, and submits that claims 1, 16 and 33, as amended, distinguish over Tran '742.

For ease of reference, independent claim 1, as amended, has been reproduced below:

Claim 1

A method to facilitate procurement of information from a user operating a computer, comprising:

- a) delivering information to the user from the computer prompting the user to enter at the computer information identifying a project;
- b) delivering information to the user from the computer prompting the user to perform at the computer an action to specify accounting information that is associated to the project, said accounting information being used to track any one of expenses, disbursements and billable time;
- a) delivering information to the user from the computer prompting the user to provide to the computer customer relation information that is associated to the project, **said customer relation information being separate from information that is used to track any one of expenses, disbursements and billable time.**

Firstly, it should be noted that claims 1, 16 and 33, have been amended such that the two different types of information the user is prompted to provide, namely the accounting information and the customer relation information, have been better defined. For the purposes of the present application, the term "customer relation information" refers to information associated with any of marketing, business development, contacts, project notes and information regarding an order process (see paragraph [0040] in the application as published). This information is conceptually separate and distinct from information related to expenses, disbursements and billable time (now referred to as "accounting information").

Secondly, the Applicant respectfully submits that the above emphasized limitation of amended claim 1 is absent from Tran '742. More specifically, Tran '742 does not teach prompting a user to supply "customer relation information" that is "separate from information that is used to track any one of expenses, disbursements and billable time"[emphasis added]. To the

Application No. 10/024,266
Reply to Office Action of June 23, 2005

Patent
Attorney Docket No. 86052-6

contrary, every item a user is prompted to enter in the system disclosed by Tran '742 is in some way related to expenses, disbursements and billable time. Tran is exclusively devoted to the production of bills based on electronically logged time, expense information and all other information entered in the system. Regardless of whether that information actually appears on a bill, it is nonetheless used in some way to track expenses, disbursements and billable time. As such, Tran '742 does not teach the above emphasized limitation of independent claim 1.

In the Examiner's response to the arguments presented in the Applicant's previous response, the Examiner indicates that "personal names of attendees to an activity have nothing to do with the billing of the client". In this statement, the Examiner is referring to the "Attendees" field 438 in Figure 12 of Tran '742. The Applicant respectfully points out that the "attendees" field 438 disclosed by Tran '742 is an entry on an "Expense Sheet" 430. It should thus be apparent that the information entered in the "attendees" field 438 is used for the purposes of tracking expenses, and cannot be considered as "customer relation" information as recited in independent claim 1.

The Examiner further indicates that "even though Tran considers the attendees field as travel-related expense information, an expense is not necessarily related to actual billing of a client". The Applicant draws the Examiner's attention to the fact that claim 1 now specifies that customer relation information is "separate from information that is used to track any one of expenses, disbursements and billable time". Again, since the attendees field 438 disclosed by Tran '742 is used to track expenses it does not qualify as "customer relation information" as recited in independent claim 1, regardless of whether it appears on an actual bill.

In light of the above, the Applicant respectfully submits that Tran '742 does not disclose, teach or suggest the above emphasized limitation of independent claim 1. Given that the same limitation can also be found in

Application No. 10/024,266
Reply to Office Action of June 23, 2005

Patent
Attorney Docket No. 86052-6

independent claims 16 and 33, the Applicant respectfully submits that Tran '742 also fails to teach at least one limitation of each of independent claims 16 and 33.

As per §2131 of the MPEP, in order "to anticipate a claim, the reference must teach every element of the claim". Since Tran '742 does not teach every limitation of independent claims 1, 16 and 33, the Applicant respectfully submits that this reference does not support a rejection based on anticipation. Thus, the Examiner is respectfully submitted to withdraw the rejection of claims 1, 16 and 33.

C) RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. 103

On page 2 of the Office Action, the Examiner has rejected claims 2-15, 17-32 and 34-46 under 35 U.S.C. as being unpatentable over Tran '742.

The Applicant respectfully disagrees with the Examiner's rejection for the reason presented below.

Firstly, claims 2-15, 17-32 and 34-46 depend either directly or indirectly on one of claims 1, 16 and 33 and therefore include by reference all the limitations of their respective base claim, including the aforementioned limitation that is absent from Tran '742. In accordance with §2142 of the MPEP, in order to establish a *prima facie* case of obviousness, the reference cited must teach all the limitations found in the claim. Given that the reference cited by the Examiner does not disclose all of the limitations of base claims 1, 16 and 33, and given that claims 2-15, 17-32 and 34-46 incorporate the limitations contained in these claims by reference, the Applicant respectfully submits that Tran '742 is insufficient to establish a *prima facie* case of obviousness as per §2142 of the MPEP.

Application No. 10/024,266
Reply to Office Action of June 23, 2005

Patent
Attorney Docket No. 86052-6

Secondly, in reference to claims 2, 17 and 34 and claims 14, 28 and 42, the Examiner concedes that Tran '742 "lacks the specific teaching of sending the first message and second message to different destinations, specifically the second message to a knowledge database". However, the Examiner proceeds to state that "It would have been an obvious design choice to one of ordinary skill in the art [...] to have separate, but linked, databases for billing information and unrelated information as is known in the art to separate personal notes from professional information or to provide a means for selective access to information."

The Applicant respectfully directs the Examiner's attention to the case of *In re Zurko* 258 F.3d 1385, 59 USPQ2d 1697 (Fed Cir. 2001) which states "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense'." The Applicant respectfully submits that the Examiner is doing exactly what the Federal Circuit is cautioning against.

As described above, nowhere does Tran '742 disclose prompting a user to enter both "customer relation information" and "accounting information". As such, since Tran '742 does not teach these two different types of information, the Applicant fails to appreciate how a person of ordinary skill in the art would have been motivated to modify Tran '742 to send these two types of information to "different destinations". Accordingly, the Applicant respectfully submits that the limitations of claims 2, 17, 34, 14, 28 and 42 would not have been obvious in light of Tran '742.

In view of the foregoing additional reason, it is respectfully submitted that a rejection under 35 U.S.C. 103 is improper, and the Examiner is respectfully requested to withdraw the rejection to all of claims 2-12, 14-15, 17-24, 28-31, 34-45.

Application No. 10/024,266
Reply to Office Action of June 23, 2005

Parent
Attorney Docket No. 86052-6

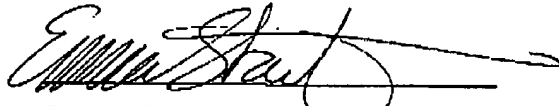
CONCLUSION

In light of the arguments presented above, the Applicant is of the view that claims 1-46 are in allowable form. Favourable reconsideration is requested. Early allowance of the Application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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